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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 08/710,645 | 09/18/1996 | MICHAEL R. LEVINE | LVN-08202/03 | 8009 |

25006 7590 01/19/2007

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| EXAMINER | |
|---|---|
| BROWN, RUEBEN M | |
| **ART UNIT** | **PAPER NUMBER** |
| 2623 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 01/19/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 08/710,645 | LEVINE, MICHAEL R. | |
| | Examiner | Art Unit | |
| | Reuben M. Brown | 2623 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10/28/02*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. In view of the Appeal Brief filed on 10/28/2002, PROSECUTION IS HEREBY REOPENED. A non-final rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4-9, 11-14, 16 & 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Inomata, (U.S. Pat # 5,473,317).

Considering claims 1, 11 & 16, the claimed TV module adapted for use in conjunction with a remotely controllable associated unit, comprising;

'a remote-control signal transmitter adapted to transmit signal representative of control codes to the associated unit', is met by the disclosure in Inomata, that the remote control unit 21 transmits operating signals to a plurality of different receiver devices, (Fig. 4; col. 2, lines 55-67). Also, the AV center 1 includes a remote control signal generator 33, which generates a remote control signal which is transmitted to the remote control optical signal radiator 9, which in turn transmits the signal to the appropriate AV component, i.e., TV, VCR, laserdisc player, etc., (col. 3, lines 22-29).

'means adapted to analyze the operation of the associated unit in response to the control codes', reads on the status detector 35, which detects the status of the AV component, (col. 3, lines 30-40.

'memory operative to store remote-control codes including the energization codes for associated units provided by a variety of manufacturers', is met by the ROM included within the registering processor 27, that stores different remote control codes employed by the manufactures of the AV components, (col. 3, lines 8-15; col. 3, lines 38-67).

'an electronic controller means adaptive to perform the following functions';

'cause the remote control signal transmitter to transmit test control signals to the associated unit', reads on the disclosure in Inomata that "power ON" codes from a plurality of manufacturers of AV components are read out of the register and transmitted to the appropriate AV component, (Fig. 5; col. 3, lines 42-56).

'cause the instant means adapted to analyze the operation of the associated unit, to determine whether the associated unit has been energized in response to the test control codes', is met by the operation of the status detector 35, which determines whether the AV component is turned ON in response to the power ON command transmitted in step 402, (Fig. 4; col. 3, lines 30-38; col. 3, lines 55-65).

'cause the control codes determined to be related to the associated unit to be stored in memory', is met by the disclosure that if the detector 35 determines that the AV component has been turned ON in response to the "power ON" command, the instant "power ON" command is then registered (step 404) as the power code of the instant AV component, (col. 3, lines 55-61; col. 4, lines 1-25).

Considering claims 4 & 19, 'wherein the associated unit is a satellite receiver', Inomata teaches that the system is operable with a satellite tuner (BS tuner), see col. 3, lines 45-47.

Considering claims 5 & 20, 'wherein the associated module is a video recorder, Inomata teaches that a VCR 17 may be one of the AV components, see Fig. 4.

Considering claims 6-9, 12-14 & 21, Inomata teaches that the status detector 35 includes a sync. separator which receives video signals and detects the presence of horizontal and vertical synchronous signals, in order to determine the status of the instant AV component, (col. 3,lines 30-37).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2 & 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Inomata, in view of Furrey, (U.S. Pat # 6,049,653).

Considering claims 2 & 17, 'wherein the TV module is a video recorder', in Inomata the AV center 1 reads on the claimed 'TV module', but it is not included within a VCR unit. Nevertheless Furrey, which is in the same field of endeavor provides a teaching of a VCR unit 200 that includes a microprocessor 110, ROM 114 and RAM 116, which are used for controlling the operation of a CATV set top box 210, see (Abstract; col. 3, lines 25-67; col. 5, lines 5-25; col. 6, lines 1-12; col. 6, lines 52-67). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Inomata to utilize the VCR as the TV module, as disclosed in Furrey, at least for the desirable benefit of reducing the number of components, necessary to operate the system.

6. Claims 3, 10, 15, 18 & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inomata.

Considering claims 3 & 18, 'wherein the associated unit is a cable tuner/descrambler', Inomata discusses the use of a TV receiver, satellite receiver, VCR and laser disc player, as optional AV components, and discloses that other AV components may be used (col. 4, lines 28-31), but does not explicitly mention a cable TV set top box. Official Notice is taken that at the

time the invention was made, CATV set top box was well known in the art of AV components. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Inomata to include a CATV set top box, for the desirable advantage of providing the subscriber another venue for accesing a wider variety of programming.

Considering claims 10, 15 & 22, Official Notice is taken that at the time the invention was made, audio or acoustic sensors were well known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Inomata with the technique of using audio sensors to detect the operation of a particular AV component, at least for the purpose of providing an additional test of the status of the instant AV component.

***Response to Arguments***

7. Applicant's arguments with respect to claims filed 10/28/2002 have been considered but are moot in view of the new ground(s) of rejection.

It is noted that independent claims 1, 11 & 16 recite, 'a TV module adapted for use...'. Likewise, independent claim 1 recites, 'a remote-control transmitter adapter to...'; 'memory operative to store...'; 'means adapted to analyze the operation... '. Furthermore independent claims 11 & 16 recite other elements 'adapted to...'.

However, MPEP 2114 reads as such:

**APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART**

>While features of an apparatus may be recited either structurally or functionally, claims< directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

**MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE**

> A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham,* 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

Examiner asserts that the "adapted to" & "operative to" language recited in the claims, corresponds with the above discussion in MPEP 2114 and thus if prior art teaches all of the structural limitations of the claim(s), then the claim(s) are met by the instant prior art.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) McConnell Teaches a system that stores control codes for a plurality of manufacturers and determines if an associated unit is operating in response to the transmitted control code.

B) Pietraszak Teaches a remote-control learning algorithm.

**Any response to this action should be mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**or faxed to:**
(571) 273-8300, (for formal communications intended for entry)
**Or:**
(571) 273-7290 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown

Reuben M. Brown
REUBEN M. BROWN
PATENT EXAMINER